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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,942	10/30/2003	Andrew B. Jones	45444	6287

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EXAMINER

FOSTER, JIMMY G

ART UNIT PAPER NUMBER

3728

DATE MAILED: 08/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/695,942

**Applicant(s)**

JONES ET AL.

**Examiner**

Jimmy G Foster

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>30 October 2003</u> . | 6) <input type="checkbox"/> Other: ____.  |

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1) Claims 8, 9, 22 and 23 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 8, the limitation, "at least two directional control devices" appears to be an indefinite double recitation of the at least one directional control device, making it unclear whether the claim requires at least two directional control devices or at least three directional control devices.

In claim 22 there is no antecedent basis for "said base portion".

2) The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States

(e) the invention was described in

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3) Claims 1, 4-7, 10, 11, 14-17 and 19-21 are rejected under 35 U.S.C. § 102(e) as being anticipated by Grossman et al (6,347,796). It is noted that the limitation, regarding the positioning of the game controller begins with "whereby." The term "whereby" is broad enough to mean "by means of which." Therefore, the game controller is treated as intended use in claim 1

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and not as structure. The "whereby" clause constitutes a functional limitation and not a structural limitation. See In re Mason, 114 USPQ 127.

The Reference of Grossman et al discloses a video game case which holds a hand-held video game and which may be considered to be a packaging. Insofar as Applicant has claimed, the case of Grossman et al includes a first section at the portion of case 12 not including the flaps 16,18, and includes a second section at the flaps 16,18.

Regarding Applicant's claim 1, although the reference of Grossman et al does not disclose a directional device being covered, the case is inherently capable of holding a controller which includes a directional located to be covered by the a portion of section 12 and which includes a button which is exposed, such as by the cut-out 14.

Regarding claims 4-7 which appear to claim the controller as structure but does not claim the location of the buttons and directional control device with respect to the handles, the claim does not distinguish over the case and game/controller of Grossman et al, which may use the flap/section 16 to cover the buttons (the circular shapes and thin "dash" shapes in Figures 1 and 2B) and directional control device (the "plus" shape shown in Figures 1 and 2B), and which may use the flap section to expose the cut-out 14 and said buttons and directional control device. Inasmuch as a handle may be anything that can be grabbed, the portion which includes the screen, buttons and control device exposed by the cut-out 14, as shown in Figure 1, may be considered to define a first handle, and the portion not exposed by the cut-out 14 may be considered to define a second handle.

Regarding the limitation in claim 10 which calls for an opening through which the controller is adapted to extend, Figure 2B of Grossman et al shows an opening 13 created when the flaps 16,18 are opened through which a portion

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of the controller 5 may extend. Inasmuch as the base of the case may be considered together with the flaps to define a section, the opening may be considered to be located between the first and sections of Grossman et al, insofar as claimed by Applicant.

Regarding claims 11, 14, 15 and 16 which claim the controller as structure in the claim (by way of the last limitation) but does not claim as structure the covering of the main portion and the second control device and the exposure of the first handle and first control device, Applicant's claim does not distinguish over Grossman et al. Moreover game controllers of the type as element 5 of Grossman et al are normally handled by a player wherein one hand is placed on one side of the controller, such as where the round buttons are located, and the other hand is placed on the other side of the controller, such as where the "plus" shaped directional control device button is shown. Additionally, one of the sides may be defined as a main portion, insofar as Applicant has claimed. The flap section 16,18 of the case/package of Grossman et al is capable of being closed to cover all of the control devices of the controller 5 and any surface portion that may be used as a main portion or second handle, and the flap section 16,18 is capable of being opened to expose said control devices and any surface portion adjacent thereto which may be defined as being a handle.

Regarding claim 17, although the controller is positively recited as structure in the claim, the claim does not distinguish over Grossman et al. The case/package of Grossman et al has front and back portions, including a front portion define by flaps 16,18 and the face which includes the cut-out 14, and by a back portion defined by all other parts of the case. When the

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front portion flaps 16,18 are closed, all portions of the controller 5 of Grossman et al are enclosed, including the side portions of the controller which will be handled by a player, and a main portion which includes a screen. Figure 2B shows that the flaps folded open and the case may be opened so as to extend a portion of the controller out of the opening. The controller may be extended through said opening so as to expose the control buttons, insofar as Applicant has claimed.

In claim 19, the controller is not claimed as structure in the claim but as intended use. Applicant is directed to MPEP 2114 regarding how intended use/functional limitations are to be treated. The case 12 of Grossman includes a cavity which is capable of receiving a controller such as claimed by Applicant, including a main portion, a first handle, a second handle, a control button and a directional control device. The opening shown in Figure 2B is capable of extending a portion of such a controller therefrom so as to expose the control button.

Regarding Applicant's claim 21, the base of the case of Grossman et al, including the power pack 24 and the portion which holds the wire 64 (see Fig. 5), includes legs at opposite ends of the base, and may be said to define a substantially C-shape along with the remainder of the base between the legs.

4) The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

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Patentability shall not be negated by the manner in which the invention was made.

5) Claims 2, 3, 12, 13 and 18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Grossman et al (6,347,796) in view of Weatherford et al (5,435,447). Although the reference of Grossman et al does not disclose the case as being transparent plastic, the reference of Weatherford et al at col. 1, lines 15-18 suggests that a package/case may be made of transparent plastic for the purpose of viewing the content through the package material so that the content may be seen without removing the content from the package. Accordingly, it would have been obvious in view of Weatherford et al to have made the case/package of Grossman et al of transparent plastic for view in the controller through the material of the case.

6) Claims 8, 9, 22 and 23 would be allowable if rewritten to overcome the rejection under 35 U.S.C. § 112 and to include all of the limitations of the base claim and any intervening claims. In claim 8 the controller is set forth as structure in the claim. The prior art does not disclose or fairly suggest a controller positioned between first and second sections, including two directional control devices covered by at least one of the sections, wherein the controller is capable of being positioned between the sections in a manner which provides accessibility to a button and provides covering of a directional control device.

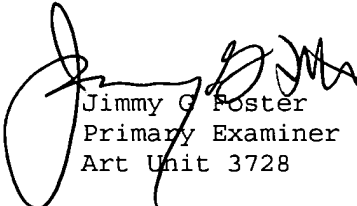
In claim 22, the game controller is recited as structure in the claim. The prior art does not disclose or fairly suggest the combination of (1) a first handle of a controller such as claimed extending through an opening, (2) legs and a first portion forming a substantially C-shape, and (3) one of said legs extending farther from a base portion than said first handle.

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7) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jimmy G Foster whose telephone number is (703) 308-1505. The examiner can normally be reached on Mon-Fri, 8:45 am - 5:15 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (703) 308-2672. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.



Jimmy G Foster  
Primary Examiner  
Art Unit 3728

JGF  
18 August 2004